

REMARKS

Applicant has filed the present Response in reply to the outstanding Official Action of August 11, 2008. Applicant believes the Response is fully responsive to the Official Action for at least the reasons set forth herein.

At the onset, Applicant would like to thank the Examiner for taking the time to have a telephone interview with Applicant's representative on October 31, 2008.

During the interview, Bernstein, Williams and Gierachf references were discussed.

With respect to the Bernstein reference, Applicant noted that the reference fails to teach (i) any consideration of **availability/unavailability**; (ii) **temporarily** storing the instant voice message; and (iii) **delivering** the stored instant voice message to the selected recipient once the selected recipient becomes **available**. The Examiner agreed to take another look at Bernstein and update the search using additional search terms.

With respect to Williams, Applicant noted that the reference fails to teach that the client requests a list of recipients associated with the client from the server and the server transmits the list of recipients to the client for selection of the one or more recipients. Williams only teaches transmitting the list of recipients if a voice command is not recognized.

With respect to Gierachf, Applicant noted that the reference is not prior art and referred the Examiner to the inventor declaration under 37 C.F.R. § 1.131.

Claims 1-3, 5, 11-18, 26-29, 43, 45, 51-54, 65 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal (previously cited) and

Bernstein, U.S. Patent Publication No. 2004/00128356. Claims 4, 19, 20, and 44 stand rejected under 35 U.S.C. § 103(a) in view of McZeal, Bernstein and Williams. Claims 7, 22 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, and Sagi. Claims 8, 23 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein and Goodman. Claims 9, 24 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein and Gierachf, U.S. Patent Publication No. 2005/0053230. Claims 10, 25 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein and Creamer et al., U.S. Pat. Pub 2003/0126207.

Claims 30-33, 35, 41, 55, 57, 63, 64, 67, 69 and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein and Monroe, U.S. Patent No. 6,970,183. Claims 42 and 76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Monroe and Boukobza. Claims 34, 56 and 68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Williams and Monroe. Claims 37, 59 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Sagi and Monroe.

Claims 38, 60 and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Goodman and Monroe. Claims 39, 61 and 73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Gierachf and Monroe. Claims 40, 62 and 74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of McZeal, Bernstein, Creamer and Monroe.

Applicant respectfully disagrees with the rejection and traverses with at least the following remarks.

Applicant submits that all of the cited references, whether taken alone or in any combination thereof, fail to teach, suggest or render obvious the limitation of the server temporarily stores the instant voice message if a selected recipient is unavailable and delivers the stored instant voice message to the selected recipient once the selected recipient becomes available, as recited in each of the independent claims.

The Official Action asserts that Bernstein teaches this feature. Applicant respectfully disagrees. As noted above, the reference fails to teach (i) any consideration of **availability/unavailability**; (ii) **temporarily** storing the instant voice message; and (iii) **delivering** the stored instant voice message to the selected recipient once the selected recipient becomes **available**.

(I) Storing only when unavailable

At best, Bernstein teaches storing all of the IM messages in a remote server, i.e., communication history or database. Bernstein teaches that the IM messages are stored for an IM session. The IM session implies that two parties are already available and IMing, i.e., a session is a flow of instant messages between at least two users.

Bernstein states that the server program system performs a step of maintained a database referencing a history of the instant messaging session with the universally unique identifier for the audience collection. See paragraphs 0086 and 0088. The audience collection is a list of users that **accepted** an invitation to the session. When and if a recipient responds to the instant messaging invitation email message, it becomes a

member of the audience collection 138. The first user sends an email invitation for the IM session and at least one other user replies to the invitation. *See* Paragraphs 0078-81.

At paragraph 0090, the reference states a step of sending the processed communication from the first member as content in the areas associated with the first member to the history of the instant message session with the universally unique identifier. The database receives the transferred communication from the first member to create a history-received communication from the first member.

In embodiments when there is a database 150, it includes a history 154 of the instant messaging session 130. History 154 includes the universally unique identifier 132 of instant messaging session 130. History 154 also includes an audience list 162 based upon audience collection 138 and a communication history 166, which further references communications records 168, each of which may be based upon at least one of the received communication 142, processed communication 144, and transferred communication 146. Additionally, in an embodiment, the server 100 may retain the complete transcript 166 of the Instant Messaging session.

In other words, **when the store feature is active, every message is stored, without a determination of whether the recipient is available. In fact, since a session is active, the recipient must be available and online (emphasis added).**

In stark contrast, in the claimed invention the IVM is only stored in the server if the recipient (IVM client) is not currently connected to the local IVM server. In fact, the reference only suggests that the IM is not stored if confidentiality cannot be maintained. *See* paragraph 0094.

(II) Temporarily storing the instant voice message if a selected recipient is unavailable

Bernstein fails to teach that the IVM is temporarily stored.

Bernstein states that the *user whenever looking at that email at any time in the future*, will trigger the server 100 to attempt fetching all the Instant Messaging messages 168 has stored for that email. *See* paragraph 0100. At any time in the future implies that the messages are stored permanently.

(III) Pushing IMV to recipient when available.

Additionally, the reference does not teach that the stored IVM is delivered to the client when the client connects to the IVM (after not being initiately connected).

Bernstein states that the *user whenever looking at that email at any time in the future*, will trigger the server 100 to attempt fetching all the Instant Messaging messages 168 has stored for that email. *See* paragraph 0100. In Bernstein, the user initiates the fetching process by sending a request, i.e., pulling the message data. In stark contrast, in the claimed invention, the server pushes or delivers the message when the recipient is determined to be available.

The other cited references fail to cure these deficiencies.

Therefore, the cited references fail to teach, suggest or render obvious each and every limitation of the claims; the claims are patentable over the cited combination.

Applicant further submits that claims 9, 24, 39, 49, 61, and 73 are patentable over the cited references based at least upon the following additional analysis. The Official Action cites Gierachf in the rejection of these claims. Applicant submits the Gierachf is

not prior art. Notably, in Applicant's declaration pursuant to 1.131, Applicant at paragraph 3 stated that the Applicant conceived the claimed invention prior to August 15 2003. *See* Declaration Pursuant to §1.131 ¶ 3. Gierachf has a filing date of September 6, 2003. Therefore, Applicant completed the invention claimed in the instant application prior to the filing date of the reference.

Applicant further submits that claims 4, 19, 34, 44, 56 and 68 are patentable over the cited references based at least upon the following additional analysis. Each of these claims recites, *inter alia*, a limitation directed to requesting a list of recipients associated with the server from the server. Applicant submits that the cited references fail to teach this limitation. At best, Williams (cited as a teaching of this limitation) teaches that the server sends a list of potential recipients **after a voice command is not recognized**. Notably, Williams describes an embodiment, where if a first word of the voice message does not satisfy a predetermined condition, the message is saved and a list of recipients is transmitted to the local client. *See* paragraph 0055. Clearly, the client is not requesting the list; rather the server determines that a command is not understood and that all available options should be transmitted to the user. The client makes no request.

Additionally, Applicant notes that this function is not in the context of an instant voice message.

None of the other cited references cure the above-identified deficiency.

Therefore, claims 4, 19, 34, 44, 56 and 68 are patentable over the cited references, whether taken alone or in any combination thereof.

Applicant further submits that claims 7, 22, 37, 47, 59 and 71 are patentable over the cited references based at least upon the following additional analysis.

Applicant submits that the references, whether taken alone or in any combination thereof teach or suggest recording an instant voice message in an audio file, at the client, where the audio file is a instant voice message, as recited in each of these claims. At best, Sagi teaches that an audio file can be transmitted to a server. Sagi teaches that an instant text message is converted into an instant voice message and then transmitted (Steps 420 and 425). The server relays the voice message to a cellular telephone. Sagi then describes that at step 435, user b sends an instant message in a voice message format to user via the gateway. The voice message is converted into a text message. Notably, Sagi does not teach that the voice message from user B to user A is recorded on the user device. None of the other cited references cure the above-identified deficiency.

Therefore, claims 7, 22, 37, 47, 59 and 71 are patentable over the cited references, whether taken alone or in any combination thereof.

Based upon the foregoing, Applicant respectfully requests that the Examiner withdraw all of the pending rejections pursuant to 35 U.S.C. § 103(a).

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the

allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Seth Weinfeld", is written over the printed name.

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